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APPLICATION NO. 59	FILING DATE 10/23/99	FIRST NAMED INVENTOR DUBOIS	ATTORNEY DOCKET NO.
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BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

EXAMINER

MOORE, M

ART UNIT

PAPER NUMBER

1712

DATE MAILED:

10/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/331,959

Applicant(s)

Dubouis et al.

Examiner

Margaret Glass Moore

Group Art Unit
1712



☒ Responsive to communication(s) filed on Jul 31, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 to 13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 to 13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 2 to 7, 9 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have not addressed, by either amendment or remark, any of the rejections with regards to these claims. As such these rejections are maintained from the previous office action.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 to 3, 9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita for reasons of record.

Applicants' traversal of this rejection is not persuasive. They note that .5 part of a 1% solution of chloroplatinic acid is added in the Comparative Examples relied upon by the Examiner for this rejection, while the claims include platinum in an amount of from 1 to 250 ppm. From this they conclude that "it does not appear" that the prior art contains platinum in the claimed amount.

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This is not sufficient to establish a difference. Note that 1% of .5 is .005 per 100. In ppm, this would be 50 ppm. Since Pt has a molecular weight of 195.08 and chloroplatinic acid has a molecular weight of 517.9, this example has 18.8 ppm platinum, as elemental platinum. This is within the claimed range.

5. Claims 4 to 8, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsushita for reasons of record.

As noted supra, arguments drawn to the amount of Pt are not persuasive.

Applicants next argue that when considering the disclosure of Matsushita as a whole, non gamma type iron oxide cannot be properly characterized as a "non-preferred embodiment". While one could argue that it cannot be considered a non-preferred embodiment of the actual invention of Matsushita, it clearly is a non-preferred embodiment when considering the entire teachings of Matsushita, including the BACKGROUND OF THE INVENTION. The inventive composition in Matsushita is an improvement over compositions containing non-gamma iron oxide. Lines 5 to 30 of column 1 clearly suggest to those of ordinary skill in the art that non-gamma iron oxide can be utilized as a self extinguishing silicone rubber composition, but just not with optimal or preferred results.

Applicants next argue that the claimed composition is "not for the same use" as that in Matsushita. This is not persuasive since, first, "the same use" requirement appears to apply to the preferred and non-preferred compositions, not to the prior art and the inventive compositions. Also, applicants haven't established that they have asserted any discovery beyond what was known in the art, as required by Gurley. Finally, since both prior art compositions and that claimed are silicone rubbers, one can argue that the compositions are "for the same use".

6. Claims 1 to 3, 8, 9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Takita et al. for reasons of record.

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7. Claims 4 to 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

Since applicants rely on the same rationale in overcome these rejections, the Examiner will similarly combine her response. Applicants state that Takita et al. fail to disclose or suggest a composition which does not include an azo-organic compound. This is not persuasive since applicants' composition is "comprising" the components claimed. This allows for the presence of the azo compound in Takita et al. Furthermore, in the comparative examples, Takita et al. show compositions having silicone, cerium oxide and platinum without any azo compound. Thus even if the claims excluded azo compounds, Takita et al. would still anticipate the claims as noted above.

8. English language translations of JP 53 6356 and JP 50 97644 are cited. Applicants are advised that these compositions appear to at least suggest some of the claim limitations, but the Examiner will not re-open prosecution in view of these references at this time, since they do not appear to be significantly closer to the claims than the references cited supra.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) **872-9310**. All other **official** faxes should be sent to (703) **872-9311**. Please do not send any informal communication or proposed amendments to this number.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
Oct. 4, 2000